

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figure 4 on sheet 2/2. Sheet 2/2, which includes Figs. 3 - 5 replaces the original sheet including Figs. 3 - 5. In Figure 4, the view line 5 – 5 has been deleted.

REMARKS/ARGUMENTS

The specification has been amended to remove reference to the view line 5 – 5. Figure 4 on sheet 2/2 has been amended to remove the view line 5 – 5. Claims 5, 8 and 14 have been amended to refer to claim 1. Claim 19 has been amended to define the height and width (not the depth) of the front sash opening as being smaller than the height and width of the investiture.

The objection to the drawings on page 2 of the Office Action is believed obviated by the amendment to the drawings. The Examiner is thanked for pointing out the discrepancy between the view line 5 – 5 in Figure 4 and the nature of the view of Figure 5.

The rejection of claims 1, 2 – 24 and 26 under 35 U.S.C. § 112 is believed obviated by the amendments to claims 5, 8, 14, and 19. The Examiner is thanked for pointing out these inadvertent errors.

The rejection of claims 1, 5 – 11 and 15 – 18 under 35 U.S.C. § 103(a) as being unpatentable over Bakalar in view of Howard and further in view of Schaller et al. is respectfully traversed. The most striking difference between applicants' claimed structure and Bakalar is the suspension of horizontally sliding sashes in front of the inside surfaces of sliding glass doors and securing at least one shutter in at least one of the sashes. So much is apparently acknowledged by the Examiner who cites Howard and Schaller to "bridge the gap", supposedly by providing these features. However, not only is there no suggestion from Bakalar to incorporate these features, indeed it would be contrary to Bakalar's structure, but the features supposedly relied on by the Examiner are actually not to be found in either Howard or Schaller et al.

Referring first to Howard, there is nothing in that reference that suggests suspension in front of a sliding glass doors. Howard locates his window construction in the window frame, not in front of a glass door or even in front of a window. There could be no basis for using Howard's window frame, which is set into a wall (column 1, lines 62 - 64. Moreover, Howard's panels are only vertically, not horizontally, movable (column 1, lines 68 – 69).

As in Howard, in Schaller et al., the frame placed around their Venetian blind is itself fixed within a window frame, not in front of a glass door or even in front of a window. See:

“connecting portions of the frame to the Venetian blind head and to the surrounding window structure.” (Emphasis added - column 1, lines 9 – 10)

“the brackets 12 (FIGS. 2 and 3) are connected to a window frame 27 by screws 28.” (Emphasis added - column 2, lines 46– 47).

The rejection of claims 12 – 14 and 19 – 27 under 35 U.S.C. § 103(a) as being unpatentable over Bakalar in view of Howard and Schaller et al., and further in view of Matimura, is respectfully traversed. Applicants have not claimed to have invented roller and track systems per se. Matimura adds nothing to the concept of suspending horizontally sliding, investiture-containing sashes in front of the inside surfaces of sliding glass doors.

To combine either Howard or Schaller with Bakalar, one would have to rip their frames from the walls into which they are set and physically incorporate them around Bakalar’s blinds, something which is foreign not only to Bakalar but also foreign to Howard and Schaller et al. Matimura cannot convert these in window, fixed structures into applicant’s invention, even with the benefit of hindsight. Applicants’ invention is not simply providing a structure that contain a blind. The Examiner ignores the other limitations of the claims that are concerned with the concept, and provides structure to suspend horizontally sliding, investiture-containing sashes in front of the inside surfaces of sliding glass doors. See M.P.E.P. 2143.01, which states, in relevant part, that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the reference. Because Bakalar is concerned only freely suspended investitures, Howard and Schaller et al. are concerned only with frames fixed into window openings, and Matimura is concerned only with partition walls, there can be no teaching, suggestion, or motivation to combine any of these secondary references with Bakalar. See again M.P.E.P. 2143.01 for the well established principle that:

“[i]f a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Similarly, M.P.E.P. 2143.01 holds:

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) there the court held that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.), precisely the situation here.


Accordingly, the underlying basis of the rejection is flawed.

In the Examiner's Response to Arguments, on page 4 of the Office Action, he stated that applicants provided no specific arguments directed at the Bakalar and Howard references, but respectfully, this is not true. Applicants specifically argued that there was nothing in Howard that suggests incorporating his blinds into the structure of Bakalar except applicants' specification, nor is there any structure in Bakalar that would permit it. (page 9, 4th full paragraph). Applicants specifically argued that neither Bakalar nor Howard disclosed or suggested a front frame. (page 9, last paragraph). Applicants specifically argued that there was nothing in Schaller et al. that suggests incorporating his blind into the structure of Bakalar except Applicants' specification, nor is there any structure in Bakalar that would permit it. (page 10, 1st paragraph). Applicants specifically argued that there was nothing in Howard or Schaller et al.(or in Boswell) that suggests incorporating their shutter blind into the structure of Bakalar except Applicants' specification, nor is there any structure in Bakalar that would permit it. (page 10, 2nd paragraph). Applicants specifically argued that there was nothing in Schaller et al. (or Boswell) that suggests incorporating their shutter or blind into the structure of Bakalar except Applicants' specification, nor is there any structure in Bakalar that would permit it. (page 10, 3rd paragraph).

Since the cited prior art references do not teach or suggest any of Applicants' claims, it is respectfully submitted that all the claims are in condition for allowance. A Notice of Allowance is respectfully solicited.

The Commissioner is hereby authorized to charge payment of any fees required associated with this communication or credit any overpayment to Deposit Account No. 50-0337. If an extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 50-0337. A duplicate copy of this paper is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Robert Berliner', written over a horizontal line.

Robert Berliner
Registration No. 20,121

December 1, 2005

Telephone: (213) 892-9237

Facsimile: (213) 892-9494